

Examiner's rejection for the reasons stated below and submits that the application is in condition for allowance.

In the Drawings

Applicant has resubmitted a copy of amended Figure 3 in accordance with the Examiner's request along with a Letter to the Draftsperson. No new matter has been added by the amendments to the reference numerals in Figure 3.

In the Claims

Claims 1, 2, 8, 9, 46 and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson et al. in view of Schlafly. Claims 3 and 4 are rejected under 35 U.S.C. §103 as being unpatentable over Johnson in view of Schlafly and Krisbergh. Claims 6 and 7 are rejected under 35 U.S.C. §103 as being unpatentable over Johnson et al. in view of Schlafly in view of Hughes et al.

As discussed in MPEP §2142, the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. Three criteria must be met :

(1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings.

(2) There must be a reasonable expectation of success.

(3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

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In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488.

Claim 1 recites "means for storing financial information of the user" and "transmitter means ... for ... transmitting the financial information of the user to the receiver unit at the remote location".

Johnson et al. is concerned with a remote control system that can control both a CATV system (300) and a digital music tuner (100). Although Figure 6 discloses a "buy" button, the button would only result in a indication signal being sent to the receiver to perform some action. In contrast, claim 1 discloses that an intelligent signal is sent from the remote unit to the receiver unit which includes the financial information of the user.

Schlaflly discloses a terminal 12 which is hardwired (I/O line 56) to a telephone to send order information to a local processing center 14. The local processing center stores information such as "the names of the subscribers or users of the terminals 12, their addresses, credit authorization" (col. 5, lines 55-63). Firstly, Applicant respectfully submits that terminal 12 is not "portable", but rather is a stationary device which is not "remote" as described in claim 1, but is actually hardwired into the network through lines 56 and 18. Secondly, Applicant respectfully submits that the financial information of the user is not stored in the terminal 12, but rather at a local processing center 14. Schlaflly discloses that product ordering information is transferred from terminal 12 to local processing center 14, but not "financial information" of the user.

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As discussed above the third prong of the obviousness test states that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Therefore, it is respectfully submitted that the third prong of the obviousness test is not met by Johnson et al. or Schlafly, alone or in combination, because neither references disclose the financial information of the user being transmitted from a remote device which has the capability of storing the financial information in memory. Johnson et al. disclose a "buy" button that sends an indicator signal to the receiver unit, but not a signal containing financial information of the user being sent from the remote unit which stores the financial information in memory. Schlafly discloses sending product order information from a stationary device which is hardwired into a system and storing the financial information of the user at local processing hub, but not sending financial information obtained from memory in a remote unit to a receiver.

As discussed above, the first prong of the obviousness test states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Schlafly is concerned with the problem of a stationary terminal 12 downloading product order information to a local processing center 14 in an efficient manner. In col. 5, lines 40-63, Schlafly discusses the problem with the slow data rate of telephone lines 18. Therefore, to improve efficiency, the terminal user's financial information is stored at the local processing center and not in the terminal 12 (col. 5, lines 55-63). Therefore, it is respectfully submitted, Schlafly does not provide motivation for storing more information such as the financial information of the user at the terminal 12, but rather teaches away from storing any more information

beyond product ordering information in the interests of improving efficiency of the download of data.

Therefore, it is respectfully submitted that claim 1 is allowable over the cited references. Since claims 2-4, 6-9, and 46-47 are dependent on claim 1 they are also believed to be allowable over the cited references.

New claims 51-52 also recite "means for storing financial information of the user" and "transmitter means ...for ...transmitting the financial information of the user to the receiver unit at the remote location" and new claim 53 recites "means for storing said financial information of the user" and "transmitter means ...for ...transmitting the financial information of the user to the receiver unit at the remote location". Therefore, for the same reasons discussed above with respect to claim 1, claims 51-53 are also believed to be allowable over the cited references. Since claim 54 is dependent on claim 53, it is also respectfully submitted to be allowable over the cited references.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that claims 1-4 and 6-54 are allowable over the cited references.

If a telephone conference would expedite the prosecution of the application in any manner, the Examiner is requested to contact the undersigned attorney.

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AUTHORIZATION

The Assistant Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account 13-4500, Order No. 1029-4012US3.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Assistant Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1029-4012US3. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,

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Dated: December 29, 1998

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